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TRANSMITTAL FORM

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Filing Date	12/09/2003
First Named Inventor	William Y. Sun
Art Unit	3739
Examiner Name	Flanagan, Beverly M.
Attorney Docket Number	

ENCLOSURES (Check all that apply)

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: William Y. Sun

Appeal No. _____

Serial No.: 10/729,973

Group Art Unit: 3739

Filed: 12/09/2003

Examiner: Flanagan, Beverly Mende

For: **TONGUE STABILIZER FOR LARYNGOSCOPE BLADE**

REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Honorable Members of the Board of Patent Appeals and Interferences:

This is a reply to the Examiner's Answer mailed 06/07/2006.

On 12/08/2005 an Appeal Brief was filed addressing the examiner's Final Rejection mailed 11/02/2005 based on the patents to Van Dam and Rooney et al.

In response to the Appeal Brief the examiner entered a New Grounds of Rejection based on the Panduit publication in an eight line 35 USC 102(b) rejection on 02/22/2006. The rejection recites surfaces of a plate and an adhesive and concludes that somewhere within the two pages and five embodiments of the publication the claim structure is anticipated.

In response to the new grounds of rejection an Amended Appeal Brief was filed on 03/09/2006 addressing the Panduit publication.

In response to the Amended Appeal Brief, an Examiner's Answer was mailed on 06/07/2006. The rejection reasoning has been expanded to three pages that include A. repeating the 8 line rejection "structure," B. addressing the preamble, and C. addressing the arguments raised in the Amended Appeal Brief.

A. The response to the eight line rejection set forth in the Amended Appeal Brief is believed to be accurate. More than a block of wood with adhesive on one side is in issue. Intubation must be rapidly performed to provide an air passage. The tongue supporting plate is supported by a foam that enables the plate to be held on different shape laryngoscope blades. The "pressure sensitive adhesive" on the foam provides instant adhesion for rapid use. The procedure cannot tolerate an eight hour cure time or even a 5 second wait. The basic deficiencies of the rejection are addressed in the Amended Appeal Brief, primarily on pages 5 - 24.

B. The examiner has unequivocally stated (page 4 of the Examiner's Answer) that the "tongue stabilizing plate for a laryngoscope blade" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight." The preamble was addressed on pages 17 and 18 of the Amended Appeal Brief.

This response by the examiner that the preamble can be ignored, because they generally are, and that it is not a limitation in the claim flies in the face of CAFC guidelines on patentability for this type claim. Their recent decision contradicts the examiner's opinion. The decision, Bicon, Inc. et al v. The Straumann Co. et al, No. 05-1168 (FedCir, March 20, 2006) is

directly on point. The preamble of a claim is properly read as a limitation when the preamble contains elements necessary to understand the scope of the claim. The argument that the preamble provided only context and should not have been considered a limitation was rejected by the Federal Circuit. An emergency cuff member for keeping the patient's gum from closing around the abutment while the jaw is healing was held to limit the claim. It was held that understanding the detailed description of the abutment's physical characteristics and the dependence of the cuff to those characteristics requires viewing them as limitations to the claimed invention.

This is directly analogous to the preamble and structure being presently claimed where the laryngoscope attached tongue support precludes the tongue from preventing intubation and oxygen deprivation to the brain. The preamble recites: "A tongue stabilizer for a laryngoscope blade," and the body of the claim recites: "a tongue-engaging plate" and "a pressure sensitive adhesive ... for attaching said tongue stabilizer to a laryngoscope blade." This clearly encompasses the preamble within provisions set forth by the Federal Circuit in Bicon, Inc. et al v. The Straumann Co. et al as being a claim limitation.

The examiner's opinion that the preamble is to be ignored is believed to be erroneous and should be reversed. The claimed "tongue stabilizing plate for a laryngoscope blade" is not analogous to the cable mounting tie mount of Panduit.

C. The Examiner's Answer in response to the Amended Appeal Brief raises several new issues that are not sufficiently addressed on pages 16 and 17 of the Amended Appeal Brief. These new issues are directly or indirectly related to the fact that the examiner has alleged but failed to show the reference to anticipate the claims.

a) The failure to identify the embodiment of the reference that is the anticipating showing is too indefinite to support a 35 USC 102(b) rejection.

b) The failure and/or refusal to comply with the requirement to match up the structures and functions of the claims and reference is too indefinite to support a 35 USC 102(b) rejection.

c). The rejection is not based on facts of record but on possibilities and unsupported, unidentified interpretation of unidentified embodiments.

d) The rejection embodiments shown by Panduit do not conform to claimed structure or function.

a) The statement (first paragraph on page 5 of the Examiner's Answer): "However Panduit clearly shows several embodiments of plates that are to have adhesive tape placed on the bottom surface." raises questions of specific identity but does not define a structural basis for rejection. It is true that Panduit shows several embodiments. It is also true that the examiner is required to read unaided on the prior art subject matter that anticipates the same claimed elements in exactly the same situation and united in the same way to perform identical functions as the single prior art reference. MPEP 707.07(g) requires an avoidance of piecemeal

examination, and undue multiplication of references, and mere conclusions coupled with stereotyped expressions. Referring broadly to plural embodiments in one reference is no different than merely broadly referring to plural references.

The recitation that Panduit shows plural embodiments (5 being shown) does not comply with MPEP 707.07(g) let alone specifically identifying the claim and reference elements, arranged as in the claim, or determine their meaning in light of the specification as is necessary to support a valid 35 USC 102 rejection.

It is not proper procedure to require the applicant, or Board of Appeals, to pick one of the five embodiments of Panduit and corresponding structure that the examiner concludes anticipates the claims. It is the duty of the examiner to specifically identify the embodiment and the elements of that embodiment and their corresponding arrangements and functions. The burden of proof is on the examiner.

This has not been done and the examiner's imagination and broad allegation that somehow the specific claimed structure is so broad it somehow inherently reads on these five embodiments so that the claims are anticipated, cannot legally be assumed, and it cannot be required that the details be supplied by "someone else."

b) No proper 35 USC 102 rejection has been made.

A 35 USC 102(b) rejection has been held historically to have specific requirements. These requirements were set forth on page 16 of the Amended Appeal Brief. The examiner has totally failed and refused to meet these requirements. The bald statement (on page 4, paragraph 9, of the Examiner's Answer) that: "Panduit teaches a plate having a top surface, a bottom surface, a forward end, a rear end, a first side, a second side and a central area, a foam support having a top surface and a bottom surface where a top surface is attached to the plate's bottom surface, a bottom surface and an adhesive having a top surface attached to and extending along the foam support bottom surface (see pages 1 and 2 of the Panduit publication). The device of Panduit is capable of attachment to a laryngoscope blade," does not specifically identify the embodiment or the elements in an embodiment or the interrelationship between the elements of an embodiment and the corresponding claim elements. The rejection appears to be a personal opinion, or wishful thinking, or intuition, and is indefinite without specific association with one of Panduit's embodiments.

These are not accidental omissions. They were not done when the rejection was first made and they were not done in the Examiner's Answer even though the omissions were specifically set forth in B, C and D on pages 9 - 11 of the Amended Appeal Brief.

There is seen to be no difference between a personal opinion and an interpretation that finds no support or necessarily modifies the claimed structure and/or prior art to create an anticipation.

c) It is required that a 35 USC 102 rejection be based on facts of record.

The examiner has rejected the claims based on the possibility or suspicion that the preamble is not a limitation in the claims and the possibility or suspicion that Panduit in one of his embodiments anticipated the claimed structure and that the structures of Panduit can possibly perform the same function as the claims. The examiner, for example, suspects that the top surface of one or more embodiments of Panduit are capable of engaging a tongue and that that would anticipate the “tongue-engaging plate” claimed since “the top surfaces of these plates are not capable of supporting a tongue) are not recited in the rejected claim’s” (Examiner’s Answer, page 5, first paragraph, lines 8 and 9).

Having “double-coated polymeric foam adhesive tape which extend on the bottom surface of the smooth-surface engaging plates (see figures on page 2)”(Examiner’s Answer, page 5, lines 15 - 17) is not having it attached to the tongue engaging plate.

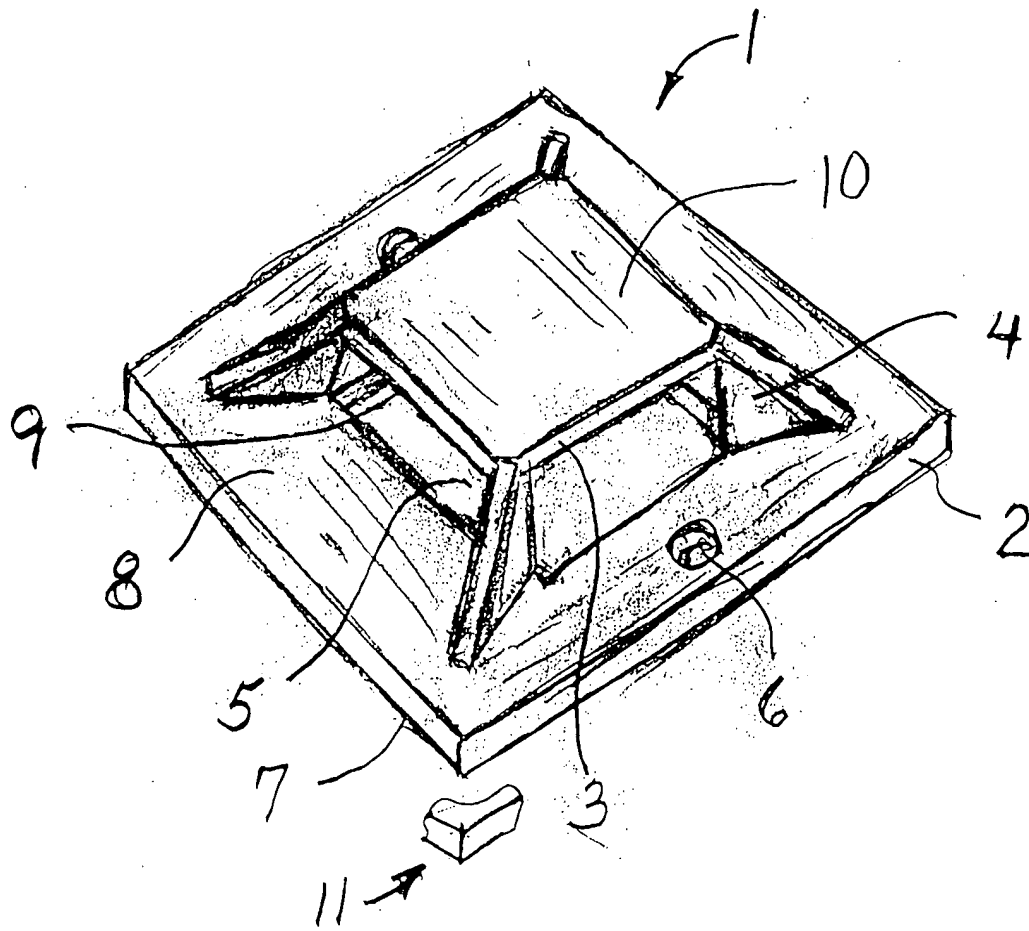
The fact that the examiner has not identified an embodiment in Panduit and the elements in that embodiment in the positions claimed performing the claimed function, fails to elevate the examiner’s position from being merely a personal opinion based on possibilities.

The Board of Appeals has long held that they will not affirm an examiner’s rejection based on suspicion. Ex parte Adams, 77 USPQ 482 (POBA 1947).

d) A close look at Panduit does not support the examiner's 35 USC 102 suspicions.

Since the examiner has failed and refused to address the specific claim structure and compared it to the reference purported to anticipate that claim, your appellant fears it may be necessary to make a factual comparison to preclude acceptance of the examiner's misrepresentation or interpretation of the prior art. To do this the top left "Cable Tie Mount" on page 1 of Panduit and that same mount application on page 2 is reviewed since the examiner concentrates remarks on this embodiment and its use.

This Panduit adhesive-backed cable tie mount 1 is sketched here. The base 2 has a central opening 5 that extends a little beyond the upper platform 3 four sides. The upper platform 3 has an upper surface 10 and a lower surface 9. The base 2 has an upper surface 8 and a lower surface 7. The upper platform is spaced above the base 2 by pillars or supports 4 at the corners. The spacing between the base upper surface 8 and the lower surface 9 of the upper platform accommodates tie downs for holding cables on the top surface 10 of the platform. The base is provided with holes 6 and is held in place with an adhesive tape depicted as 11. The cable mount 1 is secured to a surface using "pressure sensitive adhesive (foam tape) mounts" to a clean, dry grease-free surface (page 2, line 2 and Surface Preparation). The release layer is removed and thumb pressure applied for at least 5 seconds and the mount is allowed to dwell. The adhesive mounts are addressed at length in the Amended Appeal Brief (page 8, iv. and C and D of pages 10 - 12).



Rather than addressing specific arguments by the examiner that are not associated with or believed to be supported by the reference, the claim language not believed to be met by Panduit is here compared with the reference. The body of claim 1 calls for "a tongue-engaging plate," "a foam strip support" having the "top surface attached to said tongue-engaging plate bottom surface." (i) There is no foam strip disclosed by Panduit. This alone precludes anticipation. (ii) The only part of Panduit that can reasonably be considered to be a "tongue supporting plate" is the top surface 10 of platform 3. There is no foam strip attached to the platform. The adhesive tape is attached to the bottom surface 7 of base 2. This alone precludes anticipation. (iii) The platform is spaced above the base 2 so that an adhesive on bottom surface 9 could not hold the platform 3 to anything. The attachment is between "said forward

end and said rear end and between said first side and said second side.” (iv) Since there is an opening 5 in the base 2 larger than the platform 3 top surface 10, the foam adhesive strip 11 support cannot be read on the base 2 bottom surface 7 central area even if it happens to extend below the entire base. It is not disclosed how far the adhesive extends over the base 2 bottom surface 7. A pressure sensitive adhesive extends “along said foam support bottom surface and a bottom surface ... for attachment” (v) A pressure sensitive adhesive on the platform 10 bottom surface will not attach the platform (tongue engaging plate) to anything as it is spaced over the base 2. Any other interpretation of Panduit requires a modification of the Panduit structure. This precludes an anticipation rejection. (vi) There is no disclosure in Panduit that there is “a pressure sensitive adhesive” that extends “along said foam support bottom surface.” This alone precludes a valid anticipation rejection.

CONCLUSION

The publication of Panduit does not anticipate the claims and the 35 USC 102 rejection should be reversed. Such action is respectfully requested.

Respectfully submitted



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